

COMMENTS ON THE U. S. PATENT AND TRADEMARK OFFICE (PTO)
STRATEGIC PLAN 2007 – 2012
DRAFT #6 (August 21, 2006) (Draft Strategic Plan)

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EXECUTIVE SUMMARY

1. These comments include a recommendation to develop a new PTO leadership structure for the Designs Group and for issues related to design piracy and international design patent protection.
2. Another recommendation praises the Draft Strategic Plan idea to develop user products, specifically applying the proposal to design patents.
3. The last recommendation is that the PTO actively support the U. S. membership in the Geneva Act of the Hague Agreement, as a logical part of the current anti-product piracy program and to carry out the PTO role in developing effective international design patent protection.
4. Implicit in all of these comments, and formally stated in the conclusions, is that it is time, in the next PTO Strategic Plan to have separate sections on design patents and plant patents. The design patent and plant patent each of unique features and needs, while sharing some common features with utility patents.

INTRODUCTION

The extension of time to submit these comments is greatly appreciated. My professional travels prevented me from meeting the earlier deadline. The Office of the Under Secretary of Commerce for Intellectual Property and Director of the PTO was contacted and Ms. Ann Farson kindly communicated the approval to me. I was instructed to contact Ms. Francis Michalkewicz for specific guidance. These comments are sent to the Draft Strategic Plan E-mail box, at her instruction.

I commend the authors of the Draft Strategic Plan for their comprehensive organization and clarity in preparing this plan. I am well aware of the complexities in addressing the dynamic PTO operation. As a person who has worked on many domestic and international intellectual property (IP) projects for over 50 years, I found the Draft Strategic Plan carefully tuned to the real PTO situation on most topics.¹ A couple of years ago I was involved, as member of the

¹. For more information on Professor Fryer's professional service and scholarship, reference is made to the CV on his web site at URL: <http://www.fryer.com>.

University Council at the University of Baltimore, in the development and final review of its Strategic Plan.² I found that process very useful, and I consider the PTO Strategic Plan process very important, accounting for my desire to submit these comments.

You will find out immediately, when you review my service and publication lists, that I have devoted myself to two main areas of IP, Industrial design protection and utility patent law reform, although I teach a wide range of IP subjects. I will not address the utility patent law reform in these comments. My focus, where I can be most valuable as a source at this time, is in the protection of industrial designs. This topic translates into design patent protection, piracy and counterfeiting issues, domestic and international for purposes of the Draft Strategic Report.

I was a patent attorney involved in high technology utility patent work for many years before becoming a full time professor. I must confess that I find the visual appearance of a product, what is called industrial design, fascinating. It is a marriage relation for the utility patent and the design patent, with each having their unique role and valuable rights. I see the global community is actively benefitting from design patents. Recently I worked on an ABA project that reviewed the proposed 3d Amendment of the Chinese Patent Law, and I was chair of the Design Patent review committee. I saw that the Chinese were working to develop a more effective design patent system.

I am hopeful that with the leadership of the Under Secretary Dudas we can make a major step forward in this Strategic Plan, to involve the design patent in our economic planning. I know from experience that other countries and regional systems have this goal.

At this point in the Strategic Plan process, usually only small changes are made. However, it is at this point in the process that the issue I am raising needs the full attention of the PTO management. I will make several relatively concise suggestions that will plant the seeds for the PTO to take the initiative.

I know from research and writing projects that I am aware of that the issues I will mentioned will surface soon in the public arena, with a great deal of energy. I want the PTO to be in the best position to address these challenges. These comments are a “heads up” on what is coming in the near future, on the subjects of design patents relation to piracy issues, international cooperation on design patent, and the Geneva Act.

RECOMMENDATIONS FOR ADDITION TO THE DRAFT STRATEGIC PLAN

1. IMPROVEMENT IN THE DESIGN PATENT PTO MANAGEMENT

². Professor Fryer’s law school information can be found on the University of Baltimore School of Law web site, on the faculty page, at URL: <http://law.ubalt.edu>

A. I suggest the addition of text to the MANAGEMENT GOAL, STRATEGIC RESPONSE, OBJECTIVE #1 (beginning on page 35), an initiative item that states, essentially: *Develop management structure to provide adequate leadership focus that coordinates the key areas for design patent examination, domestic and international design piracy issues and external affairs policy development on international design protection.*

Background: It is apparent to me from experience with the PTO, in working on design patent projects, that there is no depth of experience or coordination available to handle the new types of issues arising domestically and internationally on design patents. This statement is not a criticism of the current or former staff who have been involved in these activities. In fact is a compliment, as I do not know how they have accomplished so much without greater formal organization structure.

As of now and for many years, the Design Patent Group 2900 has been appended to various utility patent groups for leadership. The overall effect has been to give design patents a weak position in the PTO management. It is more difficult to develop policy positions, especially on international matters, without senior staff that have this broad leadership responsibility and experience.

What I am proposing in concept, with great respect for the current Design Patent Group staff, is to give the Design Group a broader leadership role. The issues of product appearance piracy, and many other international issues involved in design patent protection, have to be worked on by persons with broad experience in domestic and international design protection.

At this point I will not discuss what might be the management structure that will best suit the PTO need. This topic can be addressed later, if my comments are wanted. I can say there is a great need for adding this initiative to the Draft Strategic Plan.

2. IMPROVE THE EFFECTIVENESS OF DESIGN PATENT LAW AND PROCEDURES.

A. I suggest the addition of text to GOAL 1, OBJECTIVE #2 (beginning on page 19), the Planned Accomplishment/Results, include an item that states, essentially: *Develop effective packages for design patents.*

Background: I will cut to the core of my impression that the Draft Strategic Plan is focused on utility patents, which is the normal situation at the PTO, of necessity. The report will not be read, by the average patent administrator, or patent attorney, as addressing specific design patent concerns. In fact, many of the design patent and utility patent issues are the same, but the merging together of all the issues under the “patent” term will leave the design patents unique issues outside the priority circle.

For that reason, it is especially important to identify the design patent topics that will be addressed in the Draft Strategic Plan.

The Draft Strategic Plan idea of developing packages in cooperation with PTO users is excellent. It is clear to me that design patents have unique needs. The issuance of prompt design protection is important to almost all design owners. The majority of countries use design patent systems that have no novelty examination and register a design promptly. This prompt design patent protection need, and other concerns, will be addressed for design patents with the proposed recommendation, in the creative initiative outline in Goal 1, Objective 2.

3. SUPPORT THE U. S. JOINING THE GENEVA ACT OF THE HAGUE AGREEMENT, AND PARTICIPATION IN DEVELOPMENT OF OTHER INTERNATIONAL DESIGN PROTECTION LAW AND PROCEDURE HARMONIZATION

A. I suggest the addition of text to GOAL 3, STRATEGIC RESPONSE, OBJECTIVE #1 (beginning on page 30), an Initiative item that states, essentially: Support U. S. joining the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs.

Background: The link between design piracy and the Geneva Act is clear to me. It will provide U. S. design owners an effective option for efficient and lower cost protection of designs in some countries. The treaty needs U. S. administration leadership to make it successful. The U. S. participated fully in developing the treaty, to conform to U. S. laws with a minimum of changes.³

It is my view that the concern over product piracy includes a challenge to the rights protected by design patents. We can reduce piracy by making it easier and effective for U. S. design owners to obtain foreign design protection. It has puzzled me why the PTO has invested so heavily in the STOP program and resolving the product piracy problem, and it has not supported actively U. S. membership in the Geneva Act. The connection seems obvious to me.

The Geneva Act is similar to the Patent Cooperation Treaty for utility patent and the Madrid Protocol for marks. It is a necessary tool for design owners. Some big U. S. companies use it in a back door way, through their foreign subsidiaries. Every U. S. business, especially the smaller companies need this opportunity.

After the U. S. administration helped develop the Geneva Act and the State Department permitted a representative to sign the treaty, the PTO has not supported actively the U.S. joining the Geneva Act. Businesses need to receive the information that is part of the PTO role in international matters, and other support that will enable U. S. ratification. The Geneva Act become operation on April 1, 2004. Now is the time to prepare the necessary

³. For more background on the history of this treaty and the U. S. extensive role, reference is made to the book by William T. Fryer, III, The Geneva Act (1999) of the Hague Agreement concerning the International Registration of Industrial Designs, Drafting History and Analysis (2005), published by Kluwer Law International.

regulations and move forward together with U. S. businesses.

CONCLUSIONS

Each of the proposed recommendations relate to how the U. S. can enhance its domestic and global economic position through more effective use of design patents. The serious concern over product piracy, that has been addressed extensively by the PTO, supports the adoption of each recommendation. The U. S. can be a leader for the protection of product appearance using design patents, as well as a leader in the legal reform and use of utility patents. Our economy dictates no less.

I will end these comments with a request for the next strategic plan, and for a new view of patents in the PTO. I am as guilty as any one in the U. S. for using the term “patents” to mean “utility patents”, cutting out the rightful role of the design patent in many discussions. In class I tell the students that there are three types of patents, and you will identify which one you are discussing in class and on exams. Habits and traditions die slowly.

I strongly suggest that in the next PTO strategic plan that separate sections be included on design patents and plant patents, that are equal statutory PTO responsibility. The Draft Strategic Plan has an excellent section on trademark. I suggest that the design patent needs an equally detailed treatment for its unique role and needs.

I hope these comments are useful. I am available to answer questions, and to assist in implementing any of these recommendations.

Respectfully submitted.

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